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OFFICE OF PETITIONS

In re Application of	:	
Mark Herrmann et al.	:	
Application No. 09/599,675	:	
Filed: June 22, 2000	:	DECISION ON RENEWED
Attorney Docket Number: 10984-	:	PETITION PURSUANT TO
287001	:	37 C.F.R. § 1.181(A)
Title: CAPTURING ADVERTISING	:	
REQUESTS FROM A USER	:	

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment, filed on April 29, 2008.

The renewed petition is **GRANTED**.

Background

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due (notice), mailed October 5, 2007, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees¹. Accordingly, the above-identified application became abandoned on January 6, 2008.

¹ See M.P.E.P. § 710.02(e).

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An original petition pursuant to Rule 1.181(a) was filed on January 24, 2008, and was dismissed via the mailing of a decision on March 17, 2008.

Relevant Portion of the M.P.E.P.

Section 711.03(c)(I)(A) sets forth, *in toto*:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

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The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Analysis

Petitioner has included the issue fee, a declaration of facts, and an assertion that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. Petitioner has further included a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO, along with a copy of the master docket for the firm, where the non-received Office action would have been entered had it been received.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the mailing was not received.

Accordingly, the holding of abandonment is WITHDRAWN.

Conclusion

Pursuant to this decision, the Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225². All other inquiries

² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.

/Paul Shanowski/
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